

**REMARKS:**

Claims 1-37 are currently pending in the subject Application.

Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,991,739 to Cupps, et al. ("*Cupps*") in view of U.S. Patent No. 4,971,406 to Hanson ("*Hanson*") and U.S. Patent No. 5,895,454 to Harrington ("*Harrington*").

Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*, and further in view of U.S. Patent No. 4,797,818 to Cotter ("*Cotter*").

**REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 1-11, 13-21, 23-34, 36, and 37 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*. Claims 12, 22, and 35 stand rejected under 35 U.S.C. § 103(a) over *Cupps* in view of *Hanson* and *Harrington*, and further in view of *Cotter*.

The Applicant respectfully submits that *Cupps*, *Hanson*, or *Harrington*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 1-11, 13-21, 23-34, 36, and 37. The Applicant further respectfully submits that *Cupps*, *Hanson*, *Harrington*, or *Cotter*, either individually or in combination, fail to disclose, teach, or suggest each and every element of Claims 12, 22, and 35. Thus, the Applicant respectfully traverses the Examiner's obvious rejection of Claims 1-37 under 35 U.S.C. § 103(a) over the proposed combination of *Cupps*, *Hanson*, *Harrington*, and *Cotter*, either individually or in combination.

**The Proposed *Cupps-Hanson-Harrington* Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant Claims**

For example, with respect to independent Claim 1, this claim recites:

**A system for brokering food order transactions among a plurality of unaffiliated sellers**, comprising:

one or more **databases** containing:

**delivery information associated with each of a plurality of buyers**, the delivery information comprises information selected from the group consisting of **a maximum delivery time preference of at least one of the plurality of buyers** and **an indication of how important the delivery time is to the at least one of the plurality of buyers**;

substantially real-time availability information identifying particular food items available from each of a plurality of unaffiliated sellers;

pricing information for the particular food items available from each unaffiliated seller; and

delivery information for each unaffiliated seller comprising a delivery area for the unaffiliated seller and substantially real-time delivery time information for the unaffiliated seller based at least in part on a current order backlog for the unaffiliated seller; and

a **food order transaction broker** operable to:

**receive a request for at least one particular food item**  
from **a** **buyer**;

**generate a list of one or more unaffiliated sellers of the requested particular food item according to** a comparison of the requested particular food item with the substantially real-time availability information for each unaffiliated seller and **a comparison of the delivery information for the buyer with the delivery area of each unaffiliated seller, the list reflecting** the pricing information for the requested particular food item for each listed unaffiliated seller, and **the substantially real-time delivery time information for each listed unaffiliated seller**; and

initiate a food order transaction concerning the requested particular food item with a particular listed unaffiliated seller selected from the list.

Independent Claims 13, 23, and 24 recite similar limitations. *Cupps, Hanson*, or *Harrington*, fail to disclose each and every limitation of independent Claims 1, 13, 23, and 24.

#### **The Office Action Acknowledges that the Proposed *Cupps-Hanson* Combination Fails to Disclose Various Limitations Recited in Applicant's Claims**

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Cupps* fails to disclose various limitations in independent Claim 1.

Specifically the Examiner acknowledges that *Cupps* fails to disclose “**the real time delivery time be provide prior to a selection be made by the customer.**” (23 February 2007 Office Action, Page 2). (Emphasis Added). However, the Examiner asserts that the cited portions of *Hanson* disclose the acknowledged shortcomings in *Cupps*.

The Examiner also acknowledges, and the Applicant agrees, that *Cupps* and *Hanson* fail to disclose “**the real time delivery time communicated to the customer prior to a transaction being initiated**”. (23 February 2007 Office Action, Page 3) (Emphasis Added). However, the Examiner asserts that the cited portions of *Harrington* disclose the acknowledged shortcomings in *Cupps* and *Hanson*. The Applicant respectfully disagrees and traverses the Examiner’s assertions regarding the subject matter disclosed in *Hanson* and *Harrington*.

*Cupps* does not disclose, teach, or suggest, that the delivery time is real time. Rather, *Cupps* merely discloses that a vendor has to press telephone keys to indicate how long it will take the order to deliver. (See column 11, lines 11-12). The Examiner jumps to the conclusion that delivery time is real time and presumes that of course this would be inherently the case. But the fact remains that *Cupps* is completely silent as to real time. Why does the Examiner presume this? It is equally plausible that the vendor is just inputting how long it will take the order to deliver without taking into account any external conditions for example and just determining delivery time in isolation. The Applicant respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight and read real time delivery in to the *Cupps* reference, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Applicant further respectfully submits that *Cupps* fails to disclose, teach, or suggest independent Claim 1 limitations regarding “a **food order transaction broker operable to: receive a request** for at least one particular food item **from a buyer**”, as recited in independent Claim 1. Rather, *Cupps* teaches only a telephone system in which “a customer desiring a pizza, or any other type of food provided by the supplier, dials the number of the telephone center 10. The incoming call is automatically assigned to an available operator at one of the CRTs 16 by the telephone service 28 employed by the

center.” (Column 3, lines 56-60). In contrast, independent Claim 1 provides a “**food order transaction broker operable to receive a request** for at least one particular food item **from a buyer**”. Accordingly, a buyer’s request is received directly by Applicant’s food order transaction broker, and doesn’t go to a telephone center operator (a person) that has to selectively enter the customer information in the appropriate field in an order entry screen of an intermediate CRT (Column 3, lines 56-60) before it is ever processed by the computer as in the system of *Cupps*. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner’s comparison between *Cupps* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Cupps*.

The Applicant respectfully submits that *Hanson* fails to disclose, teach, or suggest independent Claim 1 limitations regarding “one or more databases containing **delivery information associated with each of a plurality of buyers**, the delivery information comprises information selected from the group consisting of **a maximum delivery time preference of at least one of the plurality of buyers** and an indication of how important the delivery time is to the at least one of the plurality of buyers” and “a **food order transaction broker operable to receive a request** for at least one particular food item **from a buyer**;**[and] generate a list of one or more unaffiliated sellers of the requested particular food item according to** a comparison of the requested particular food item with the substantially real-time availability information for each unaffiliated seller and **a comparison of the delivery information for the buyer with the delivery area of each unaffiliated seller, the list reflecting** the pricing information for the requested particular food item for each listed unaffiliated seller, and **the substantially real-time delivery time information for each listed unaffiliated seller**”, as recited in independent Claim 1.

Rather, *Hanson* only discloses that an order entry station may be advised if an unusual delay in future deliveries is to be expected “so that customers can be advised accordingly”. (See Column 16, lines 66-68). In contrast, independent Claim 1 provides a “**food order transaction broker operable to: receive a request** for at least one particular food item **from a buyer**;**[and] generate a list of one or more unaffiliated**

**sellers of the requested particular food item according to** a comparison of the requested particular food item with the substantially real-time availability information for each unaffiliated seller and **a comparison of the delivery information for the buyer with the delivery area of each unaffiliated seller, the list reflecting** the pricing information for the requested particular food item for each listed unaffiliated seller, and **the substantially real-time delivery time information for each listed unaffiliated seller**". Accordingly, Applicant's food order transaction broker directly generates a list reflecting the substantially real-time delivery time information for each listed unaffiliated seller, and is not communicated to the customer indirectly, by the person on the phone at the order entry station, as in the *Hanson* system. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Hanson* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Hanson*.

The Applicant respectfully submits that *Harrington* fails to disclose, teach, or suggest independent Claim 1 limitations regarding "one or more databases containing **delivery information associated with each of a plurality of buyers**, the delivery information comprises information selected from the group consisting of **a maximum delivery time preference of at least one of the plurality of buyers** and an indication of how important the delivery time is to the at least one of the plurality of buyers" and "a **food order transaction broker operable to: receive a request** for at least one particular food item **from a buyer**, [and] **generate a list of one or more unaffiliated sellers of the requested particular food item according to** a comparison of the requested particular food item with the substantially real-time availability information for each unaffiliated seller and **a comparison of the delivery information for the buyer with the delivery area of each unaffiliated seller, the list reflecting** the pricing information for the requested particular food item for each listed unaffiliated seller, and **the substantially real-time delivery time information for each listed unaffiliated seller**", as recited in independent Claim 1.

Rather, *Harrington* only discloses that a user inputs delivery time criteria into the database interface. (See Column 5, lines 27-28). In contrast, independent Claim 1 provides a **"food order transaction broker operable to: receive a request for at least one particular food item from a buyer; [and] generate a list of one or more unaffiliated sellers of the requested particular food item according to a comparison of the requested particular food item with the substantially real-time availability information for each unaffiliated seller and a comparison of the delivery information for the buyer with the delivery area of each unaffiliated seller, the list reflecting the pricing information for the requested particular food item for each listed unaffiliated seller, and the substantially real-time delivery time information for each listed unaffiliated seller"**. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Harrington* and independent Claim 1 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Harrington*.

#### **The Office Action Fails to Properly Establish a *Prima Facie* case of Obvious over the Proposed *Cupps-Hanson-Harrington* Combination**

The Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Cupps*, *Hanson*, or *Harrington*, either individually or in combination. The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine these references as proposed. The Office Action merely states that "it would have been obvious for one of ordinary skill in the art to communicate the real time delivery time to the customer in *Cupps* prior to the order being placed" and "in a manner as disclosed in *Harrington*". (23 February 2007 Office Action, Pages 2-3). The Applicant respectfully disagrees.

The Applicant further respectfully submits that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Cupps*, *Hanson*, or *Harrington*, either individually or in combination. The Examiner asserts that the motivation

to combine the references as proposed would be “so that the customer could make **a more informed decision**” and “so that delivery time could be used by the customer as **a criteria for determining which food item to order** before beginning any transaction.” (23 February 2007 Office Action, Pages 2-3). The Applicant respectfully disagrees and further respectfully request clarification as to how the Examiner arrives at this conclusion. For example, how does “communicat[ing] the real time delivery time to the customer” relate to “make[ing] **a more informed decision**” or “as **a criteria for determining which food item to order**” and to what extent does the Examiner purport that “**a more informed decision**” or the purported “**criteria**” applies to the subject Application.

Again, ***the Applicant respectfully requests the Examiner to point to the portions of Cupps, Hanson, and Harrington, or to other specific prior art authority demonstrating the general knowledge available to one of ordinary skill in the art, which contain the teaching, suggestion, or motivation to combine these references for the Examiner’s stated purported advantage.***

For example, the Examiner’s arguments on pages 4 - 5 of the 23 February 2007 Office Action, the Examiner is relying on old case law and fails to take into account the more recent Federal Circuit case that makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

Here, with respect to the subject Application, the ***Examiner has not adequately supported the selection and combination of Cupps, Hanson, or Harrington, to render obvious the Applicant’s claimed invention.*** The Examiner’s ***unsupported*** conclusory statements that “it would have been obvious for one of ordinary skill in the art to communicate the real time delivery time to the customer in Cupps prior to the order being placed” and “in a manner as disclosed in Harrington” and “so that the customer could make a more informed decision” and “so that delivery time could be used by the

customer as a criteria for determining which food item to order before beginning any transaction", **does not adequately address the issue of motivation to combine.** (23 February 2007 Office Action, Pages 2-4).

This factual question of motivation is material to patentability, and cannot be resolved on **subjective belief and unknown authority.** *Id.* at 1434-35. **Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness.** *Id.* at 1434-35. It is clear that the Examiner can not point to any portions of *Cupps*, *Hanson*, and *Harrington*, which contain the teaching, suggestion, or motivation to combine these references. Instead, on page 5 of the 23 February 2007 Office Action, the Examiner provides only conclusory statements about his own subjective belief about what he and other consumers would want to know before making a decision. The Examiner also argues that it "**seems self-evident**". However, the Examiner's subjective belief and "self-evident"/common sense arguments cannot support a finding of obviousness. Accordingly, since the Examiner cannot point to any portions of *Cupps*, *Hanson*, and *Harrington* and wants to rely instead on the general knowledge available to one of ordinary skill in the art, Applicant **respectfully requests the Examiner to point to other specific prior art authority demonstrating the general knowledge available to one of ordinary skill in the art.**

Furthermore, it is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). **The teaching or suggestion can not be based on applicant's disclosure.** The Applicant respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a). Thus, the Office Action fails to provide proper motivation for combining the teachings of *Cupps*, *Hanson*, or *Harrington*, either individually or in combination.



**The Proposed *Cupps-Hanson-Harrington-Cotter* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicant's Dependent Claims 12, 22, and 35**

For example, with respect to dependent Claim 12, this claim recites:

The system of Claim 1, wherein the broker is further operable to ***select the particular listed seller automatically according to at least the substantially real-time delivery time information for all of the listed sellers.*** (Emphasis Added).

Dependent Claims 22 and 35 recite similar limitations. *Cupps, Hanson, Harrington, and Cotter*, either individually or in combination, fail to disclose each and every limitation of dependent Claims 12, 22, and 35.

**The Office Action Acknowledges that *Cupps-Hanson-Harrington* Fails to Disclose Various Limitations Recited in Applicant's Claims**

The Applicant respectfully submits that the Office Action acknowledges, and the Applicant agrees, that *Cupps, Hanson, and Harrington* fail to disclose the emphasized limitations noted above in dependent Claim 12. Specifically the Examiner acknowledges that *Cupps, Hanson, and Harrington* fail to disclose a ***system for brokering food order transactions among a plurality of unaffiliated sellers*** wherein the broker is further operable to ***select the particular listed seller automatically according to at least the substantially real-time delivery time information for all of the listed sellers.*** (23 February 2007 Office Action, Pages 3-4). (Emphasis Added). However, the Examiner asserts that the cited portions of *Cotter* disclose the acknowledged shortcomings in *Cupps, Hanson, and Harrington*. The Applicant respectfully disagrees and traverses the Examiner's assertions regarding the subject matter disclosed in *Cotter*.

The Applicant respectfully submits that *Cotter* fails to disclose, teach, or suggest dependent Claim 12 limitations regarding a food order transaction broker operable to ***select the particular listed seller automatically according to at least the substantially real-time delivery time information for all of the listed sellers,*** as recited in dependent Claim 12. In particular, the Examiner equates "***select[ing] the particular listed seller***

**automatically**" recited in dependent Claim 12 with the computer system disclosed in *Cotter*. (23 February 2007 Office Action, Page 3). However, the computer system disclosed in *Cotter*, merely provides for operators to manually enter information into the computer system wherein the computer system is adapted to automatically assign incoming orders to the store best able to respond to those orders and **does not include or is not even related to select the particular listed seller automatically according to at least the substantially real-time delivery time information**, as recited in dependent Claim 12. (Column 2, Lines 21-31). In contrast, the limitations recited in dependent Claim 12 provide for a food order transaction broker operable to **select the particular listed seller automatically according to at least the substantially real-time delivery time information for all of the listed sellers**. Thus, the Applicant respectfully submits that the equations forming the foundation of the Examiner's comparison between *Cotter* and dependent Claim 12 cannot be made. The Applicant further respectfully submits that these distinctions alone are sufficient to patentably distinguish dependent Claim 12 from *Cotter*.

#### **The Applicant's Claims are Patentable over the Proposed *Cupps-Hanson-Harrington-Cotter* Combination**

As mentioned above, independent Claims 1, 13, 23, and 24 are considered patentably distinguishable over *Cupps, Hanson, Harrington, and Cotter*.

With respect to dependent Claims 2-12, 14-22, 25-35, 36, and 37: Claims 2-12 depend from amended independent Claim 1; Claims 14-22, 36, and 37 depend from amended independent Claim 13; and Claims 25-35 depend from amended independent Claim 24. As mentioned above, each of amended independent Claims 1, 13, 23, and 24 are considered patentably distinguishable over the proposed combination of *Cupps, Hanson, Harrington, and Cotter*. Thus, dependent Claims 2-12, 14-22, 25-35, 36, and 37 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicant respectfully submits that Claims 1-37 are not rendered obvious by the proposed combination of *Cupps, Hanson,*

*Harrington*, and *Cotter*. The Applicant still further respectfully submits that Claims 1-37 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of Claims 1-37 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-37 be allowed.

**THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, ***and not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability,*** and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. §2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the

Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

In view of the foregoing remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although the Applicant believes no fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

23 May 2007  
Date

/Steven J. Laureanti/signed  
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC  
1155 W. Rio Salado Pkwy., Ste. 101  
Tempe AZ, 85281  
214.636.0799 (mobile)  
480.830.2700 (office)  
480.830.2717 (fax)  
steven@boothudall.com

**CUSTOMER NO. 53184**